

REMARKS

The Office Action mailed July 20, 2006, has been carefully studied. Claims 1-13 remain in the claims, and these claims define novel and unobvious subject matter under §§102 and 103, therefore warranting their allowance. Favorable reconsideration and allowance are therefore respectfully urged.

In the Reply filed January 31, 2006, the third paragraph on page 9, applicants requested the PTO to acknowledge receipt of applicants' rights under 35 USC 119(e). This has not yet been done! Therefore, applicants again respectfully request the PTO to acknowledge applicants' rights under 35 USC 119(e).

Claims 1-13 have been rejected on the basis of obviousness-type double patenting over claims 1-35 of Long USP 6,669,546 (Long '546) in view of Allen USP 3,389,997 (Allen). This rejection is respectfully traversed.

First, the rejection is confusing in its reference to "AAPA" in the context of this rejection. The term has not been defined in the rejection, and applicants question what it refers to in conjunction with this double patenting rejection.

As understood, the rejection is based on an alleged obvious modification of the claims of Long '546 by some teaching of Allen. Applicants request the examiner to explain what is being relied upon in the claims of Long '546, as same has not been explained in the rejection.

Claim 1 calls for a method as disclosed in Long '546 (but the PTO may not rely upon the disclosure of Long '546, but only on its claims in a double patenting rejection), in which the meat being treated is confined and tightly sealed within a tunnel while being subjected to the shock wave. As best understood from the rejection, which applicants find difficult to understand, the PTO seems to be taking the position that Allen discloses the confining and tightly sealing of meat within a tunnel while being subjected to a shock wave. If applicants misunderstand, clarification is requested if the rejection is to be repeated.

Regardless, Long neither claims nor discloses the use of a tunnel¹, let alone confining and tightly sealing the meat within such a tunnel while the meat is being subjected to the shock wave. Allen does not make up for what Long neither shows nor claims. Allen also does not show confining and tightly sealing meat within a tunnel while being subjected to

¹ Applicants are not taking the position that the Long claims do not dominate, but domination and double patenting are two different matters, MPEP 804. "Domination and double patenting should not be confused. They are two separate issues. ... Domination by itself... cannot support a double patenting rejection." [citations omitted]

any shock wave. Therefore, even if the combination were obvious, which it would not have been, the modification of the claims of Long '546 by anything taught by Allen would not reach applicants' claim 1 or any of the claims which depend therefrom.

In more detail, Allen does not disclose a tunnel of any type, and does not disclose the treatment of meat. Allen does disclose a container or vessel 10 defining a reaction chamber 11. Section 11a of the chamber 11, in which an electrode is provided to create a shock wave, is separated by a diaphragm 12 from the lower chamber 11b into which is placed a receptacle 30 having a perforate bottom 31 and into which is provided particles 32 of a parent material having intracellular protein suspended in a liquid. In the illustrated embodiment, decorticated peanuts are suspended in a 10% saline solution in the lower chamber 11b.

Again, there is no tunnel whatsoever. There is no teaching of the treatment of meat whatsoever. There is no teaching whatsoever of confining and tightly sealing meat within a tunnel. Respectfully, there is no way that modification of the claims of Long '546 by anything taught by Allen would even begin to reach claim 1.

Furthermore, applicants wish to make very clear their strong position that there is nothing in Allen which

would have led the person of ordinary skill in the art to attempt to modify anything in Long. They are similar only in using shock waves on food with the shock wave generating chamber being disposed above the food treatment chamber and with a diaphragm of some unknown material and construction therebetween. The purpose in Allen is entirely different from any purpose in the claims of Long '546, it being clear from Allen that the purpose is to break up the particles 32 of the parent material (e.g. peanuts) so as to "release the intracellular proteins into the surrounding liquid medium" (see the abstract of Allen; also the introductory paragraph at column 1, lines 20-24, and elsewhere in Allen as well).

The person of ordinary skill in the art, considering Allen in conjunction with the claims of Long, would perceive their objectives to be contradictory, it being desired in Long to tenderize meat and in Allen to drive the protein from particles 32 of the parent material, i.e. to destroy the parent material particles.

Accordingly, claim 1 and the claims which depend therefrom would not have been obvious from the claims of Long '546 in view of Allen.

The claims which depend from claim 1 add additional details which would not have been obvious from the proposed combination.

Claim 8 is a second independent claim which would not have been made obvious from a consideration together of Allen and the claims of Long '546. Some of the comments made above with regard to claim 1 apply equally to claim 8, and are therefore repeated by reference. In this regard, applicants particularly traverse the idea that the proposed combination of the claims of Long and the disclosure of Allen would have been obviously combinable, taking into account their very different objectives.

Thus, for example, in the claims of Long the meat must be placed adjacent a surface of the membrane, whereas in Allen the particles 32 of the parent material must be free to float in liquid. From Allen commencing at column 2, line 52:

After the apparatus has been charged with liquid, the electrode 25 is discharged so that a shock wave is generated which will be transmitted through diaphragm 12 on into the lower reaction chamber 11b. Travel of the shock wave through the mixture causes the particles [32] to give up protein.

This makes no sense in the context of the claims of Long '546

Additionally, it has been found that if the perforate separator 31 is present, the protein bearing material is forced through the openings therein and physically disintegrated. This physical action further aids in the recovery of protein.

And in the example using peanuts, what was produced was "peanut meal."

Allen is incompatible with and contrary to the claims of Long '546. The proposed combination would not have been obvious.

Claim 9 is an apparatus claim dependent on method claim 8. Again, the proposed combination would not have been obvious for the reasons pointed out above, including the fact that Allen is absolutely incompatible with the claims of Long '546. Moreover, even if they were not incompatible, there would have been no reason or purpose, motive or incentive for changing anything in the claims of Long '546 in view of Allen to provide the apparatus of claim 9.

Accordingly, withdrawal of the rejection insofar as it applies to claim 9 is also in order and is respectfully requested.

Claim 10 is a second apparatus claim, dependent from and incorporating the subject matter of method claim 1. Applicants' remarks made above with respect to the double patenting rejection applied against claim 1 are respectfully repeated by reference. Applicants particularly note that there is nothing in Allen to provide a sealed tunnel space, let alone one having any kind of tunnel end walls, especially moveable metal end walls.

Withdrawal of the rejection is in order and is respectfully requested.

Claim 1 has been rejected as anticipated by Long U.S. published patent application 2002/0072318, which is the published U.S. Application which eventually matured into Long '546. This rejection is respectfully traversed.

First, the rejection makes no sense to applicants as the rejection is stated to be based on anticipation under §102, when it is absolutely clear that there is nothing in the published Long application of confining meat and tightly sealing it within a tunnel. The matter then becomes more confusing to applicants in that this rejection, purportedly based on alleged anticipation, then confusingly states as follows:

It would have been obvious to one of ordinary skill in the art to incorporate the features of Allen into AAPA since both are directed to methods and devices for applying shock waves to food,

Is this supposed to be a rejection based on anticipation (§102) or obviousness (§103)?

Applicants have pointed out above that the objectives of Allen are contrary to those of Long. Consequently, there would have been no motive or incentive, no reason or purpose to even attempt to combine these diverse

disclosures.² The proposed combination is only obvious **after** one has reviewed applicants' invention, but not at the time the present invention was made. Applicants respectfully repeat by reference the remarks made above as to the non-obviousness of the proposed combination.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 9 and 10 have been rejected under the second paragraph of §112. The rejection is respectfully traversed.

While applicants believe that the claims as previously drafted fully conform with the second paragraph of §112, applicants have nevertheless amended claims 9 and 10 as inferentially suggested by the examiner. Clearly, this is a cosmetic amendment which does not involve any change in scope whatsoever. No limitations have been added and none are intended.

Some other minor amendments have also been introduced into the claims in order to improve the form of the claims.

Withdrawal of the rejection is in order and is respectfully requested.

² The mere fact that two reference both originate from the same art does not provide any teaching or suggestion to combine them, *In re Levitt*, 11 USPQ2d 1315, 1316 (Fed. Cir. 1989).

Claims 1, 4, 5 and 7-10 have been rejected as obvious under §103 from what is stated to be applicants' admitted prior art (AAPA) in view of Allen. Similarly claims 2, 3, 6 and 11-13 have been rejected as obvious under §103 from AAPA in view of Allen and further in view of the aforementioned published application of Long. Both of these rejections are respectfully traversed.

Applicants' remarks above in response to the obviousness-type double patenting rejection and the confusing "anticipation" rejection of claim 1 based on a combination of the Long publication in view of Allen apply fully to these rejections and are respectfully repeated by reference. First and foremost, the proposed combinations would not have been obvious for the reasons pointed out above, the Long publication and AAPA being incompatible and contrary to Allen, and vice versa. Moreover, none of the "references" would have led the person of ordinary skill in the art to the provision of a tunnel within which the meat is confined when subjected to the treatment.

Withdrawal of the rejections is in order and is respectfully requested.

The additional prior art document made of record and not relied upon by the PTO has been noted, along with the implication that such document is deemed by the PTO to be

Appln. No. 10/714,908
Amd. dated November 20, 2006
Reply to Office Action of: July 20, 2006

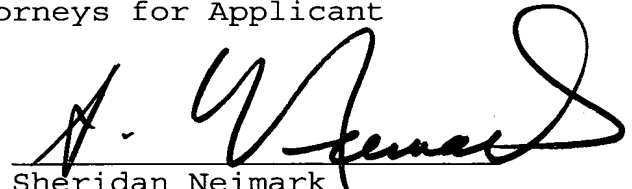
insufficiently material to warrant its application against any
of applicants' claims.

Applicants believe that all issues raised in the
Official Action have been addressed above in a manner that
should lead to patentability of the present application.
Favorable consideration and early formal allowance are
respectfully requested.

Respectfully submitted,

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